

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HEINZ RASEL

Appeal No. 98-0384
Application No. 08/579,639¹

ON BRIEF

Before MEISTER, ABRAMS, and FRANKFORT, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

DECISION ON APPEAL

Heinz Rasel (the appellant) appeals from the final rejection of claims 2, 8, 13, 17, 18 and 20. Claims 3-6, 9-12 and 15 have been indicated as being allowable subject to the

¹ Application for patent filed December 27, 1995. According to appellant, this application is a continuation of Application 08/252,862 filed June 2, 1994, now abandoned.

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requirement that they be rewritten to include all the subject matter of the claims from which they depend. Claim 21, the only other claim remaining in the application, stands allowed.

We REVERSE and, pursuant to our authority under the provisions of 37 CFR § 1.196(b),² we will enter a new rejection of claims 2-6, 8-13, 15, 17, 18 and 20.

The appellant's invention pertains to packaging for a strip of photosensitive material. Independent claim 20 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the brief.

The references relied on by the examiner are:

Weaver 1918	1,260,491	Mar. 26,
Pomeroy et al. (Pomeroy) 2, 1957	2,797,804	Jul.
Syracuse et al. (Syracuse) 1979	4,148,395	Apr. 10,
Takahashi et al. (Takahashi) 29, 1993	5,222,601	Jun.

Claims 2, 8, 13 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Syracuse in view of Takahashi, Weaver and Pomeroy.

² Amended effective December 1, 1997.

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Claims 17 and 18 are rejected under 35 U.S.C. § 103 over the references as applied to claims 2, 8, 13 and 20 above, and further in view of the "conventional use of perforations."

The rejections are explained on pages 3 and 4 of the answer. The arguments of the appellant and examiner in support of their respective positions may be found on pages 2-7 of the brief and pages 5-8 of the answer.

OPINION

For reasons stated *infra* in our new rejection under the provisions of 37 CFR 1.196(b), we are of the opinion that claims 2-6, 8-13, 15, 17, 18 and 20 fail to satisfy the requirements of 35 U.S.C. § 112, second paragraph. We note that normally a claim which fails to comply with the second paragraph of § 112 will not be analyzed as to whether it is patentable over the prior art since to do so would of necessity require speculation with regard to the metes and bounds of the claimed subject matter. **See *In re Steele***, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962) and ***In re Wilson***, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

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Nevertheless, in this instance, in an effort to avoid piecemeal appellate review (*see Ex parte Saceman*, 27 USPQ2d 1472, 1474 (Bd. Pat. App. & Int. 1993) and *Ex parte Ionescu*, 222 USPQ 537, 540 (Bd. App. 1984)) we make the following interpretations of the terminology appearing in the claims for the purpose of reaching the rejections based on prior art. In independent claim 20, lines 15-19, (as it appears in the appendix to the brief) we interpret "curved overhanging edge portions . . . curving towards the essentially flat end faces" to be:

-- overhanging edge portions attached to the outer axial edge portions, the overhanging edge portions extending beyond the width of the strip and adapted to be deflected along a curved path towards the essentially flat end faces; --.

Turning to the rejections of claims 2, 8, 13, 17, 18 and 20 under 35 U.S.C. § 103, both of these rejections are bottomed on the examiner's position that:

Syracuse shows a package comprising a roll of photosensitive material (10), an opaque cover sheet (14), a core (12), and opaque end cap covers (18 and 20) substantially as claimed except for the exact width of the cover sheet and the exact end caps. Takahashi '601 teaches making a cover sheet wider than the width of the roll of material and to overlap the cover sheet edges with the edges of the

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flexible end covers (figure 28) and teaches providing a hub (18) inserted into a core (11). Weaver teaches providing a sealing disk (3) with a hub-shaped section (5) and a flexible section (8) as an end cap. Pomeroy teaches providing end caps comprising a hub-shaped section (3) with a sealing disk (2) on a photosensitive material package. It would have been obvious to provide a wider cover and fold over the edges and to provide a hub as taught by Takahashi '601, and to provide a sealing disk as taught by Weaver and/or Pomeroy in the end caps of the package of Syracuse to provide secure edges and to increase protection of the ends of the material even when a portion of the material has been dispensed.

In reference to the "curved overhanging edge portions", when the cover of Syracuse are [sic, is] rolled around the roll of photosensitive material the edges are inherently curved. [Answer, pages 3 and 4.]

We will not support the examiner's position. It is well settled that it is the teachings of the prior art taken as a whole which must provide the motivation or suggestion to combine the references. **See Uniroyal, Inc. v. Rudkin-Wiley Corp.**, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) and **Interconnect Planning Corp. v. Feil**, 774 F.2d 1132, 1143, 227 USPQ 543, 550-51 (Fed. Cir. 1985). Here, absent the appellant's own disclosure, we can think of no reason why one of ordinary skill in this art would have been motivated to

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combine the teachings of Syracuse, Takahashi, Weaver and Pomeroy in the manner that the examiner has proposed. With respect to Syracuse and Takahashi, the examiner apparently is proposing to extract from the teachings of Takahashi the feature of a cover sheet (which has overhanging portions that are adapted to be curved downwardly towards the flat end faces of the coiled strip of photosensitive material as illustrated by Takahashi in Fig. 28) and incorporate this feature into the packaging of Syracuse, while at the same time retaining Syracuse's "end cap covers" or flexible sections 18 and 20. The examiner, however, may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. **See Bausch & Lomb, Inc., v. Barnes-Hind/Hydrocurve Inc.**, 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), **cert. denied**, 484 U.S. 823 (1987) and **In re Kamm**, 452 F.2d 1052, 1057, 172 USPQ 298, 301-02 (CCPA 1972). Here, Syracuse and Takahashi simply teach **alternative** ways of covering the flat end faces of a coiled photosensitive

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strip. On the one hand, Syracuse teaches that the flat end faces should be covered by flexible sections 18 and 20. On the other hand, Takahashi teaches the covering of the flat end faces by providing the cover sheet 13 (which covers the outer circumference of the coiled photosensitive strip) with lateral extending or overhanging portions 15 which are folded across the essentially flat end faces in such a manner that the end faces are completely covered. There is simply nothing in the combined teachings of Syracuse and Takahashi which would fairly suggest providing the packaging of Syracuse with overhanging portions 15 as illustrated by Takahashi in Fig. 28 for the purpose of covering the flat end faces and, at the same time, **retaining** the flexible sections 18, 20 which Syracuse teaches should be used for this same purpose.

As to the examiner's position that it would have been obvious to provide a sealing disk "as taught by Weaver and/or Pomeroy" in the end caps of the package of Syracuse, Pomeroy once again teaches another alternative way of covering the flat end faces of coiled photosensitive material. To this end, Pomeroy provides a cover member 2 which is secured to the flat end faces of coiled photosensitive material by means of

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an adhesive layer 12. There is simply nothing in the combined teachings Syracuse and Pomeroy which would suggest providing the packaging of Syracuse with a cover member or "sealing disk" for the flat end faces as taught by Pomeroy and at the same time **retain** the flexible sections 18 and 20 which Syracuse teaches should be used for this same purpose. While the examiner has also relied on the teachings of Weaver for a sealing disk, Weaver merely teaches the provision of a wooden member 3 which is used to protect the ends of paper rolls during shipping. However, this wooden member performs no sealing function and cannot, in our view, be fairly construed to teach a "sealing disk" as claimed.

From our perspective, the examiner has impermissibly relied upon the appellant's own teachings in arriving at a conclusion of obviousness. This being the case, we will not sustain the rejections under 35 U.S.C. § 103 of claims 2, 8, 13 and 20 based on the combined teachings of Syracuse, Takahashi, Weaver and Pomeroy and claims 17 and 18 based on the combined teachings of Syracuse, Takahashi, Weaver, Pomeroy and the "conventional use of perforations."

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Under the provisions of 37 CFR § 1.196(b) we make the following new rejection:

Claims 2-6, 8-13, 15, 17, 18 and 20 are rejected under 35 U.S.C. 112, second paragraph. In order to satisfy the requirements of the second paragraph of §112, a claim must accurately define the invention in the technical sense. **See In re Knowlton**, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). Here, the claims are directed to **packaging** for a strip of photosensitive material (which is to be coiled), as distinguished from a completed package containing such a coiled strip. That is, the claims on appeal define the packaging in an undeformed or "flattened" state **before** the coiled strip is wrapped or enclosed (e.g., independent claim 6 sets forth a cover sheet "for" being wound on the roll outer circumferential surface and flexible sections "for" covering the essentially flat end faces). This being the case, the cover sheet does not have edge portions which are **curved** as set forth in lines 15-19 of independent claim 6. Instead, these portions are merely **adapted** to be deflected in a curved con-

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figuration when the packaging is actually used to enclose the coiled strip of photosensitive material.

In summary:

The rejections of claims 2, 8, 13, 17, 18 and 20 under 35 U.S.C. § 103 are reversed.

A new rejection of claims 2-6, 8-13, 15, 17, 18 and 20 under 35 U.S.C. 112, second paragraph, has been made.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new

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ground of rejection to avoid termination of proceedings
(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

REVERSED
37 CFR § 1.196(b)

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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